

## REMARKS

Claims 11-14 are presently pending in this application. Claims 11-14 have been amended to more particularly point out and distinctly claim the subject matter of the present invention. The amendments are fully supported by the specification. No new matter is added.

### Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected Claims 11-14 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent No. 4,844,909 to Goldie *et al.* ("Goldie") in view of U.S. Patent No. 4,547,359 to Zierenberg *et al.* ("Zierenberg"), or over Goldie in view of U.S. Patent No. 3,458,622 to Hill ("Hill"). Applicants respectfully traverse these rejections.

When rejecting claims under 35 U.S.C. § 103, the Examiner bears the burden of establishing a *prima facie* case of obviousness. *In re Bell*, 26 USPQ2d 1529 (Fed. Cir. 1993). To establish a *prima facie* case, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the reference teachings in the manner suggested by the Examiner. *See, e.g., In re Grabiak*, 226 USPQ 870 (Fed. Cir. 1985). Second, the skilled artisan, in light of the teachings of the prior art, must have had a reasonable expectation that the modification or combination suggested by the Examiner would be successful. *See e.g., In re Dow*, 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988). Finally, the prior art reference, or references when combined, must teach or suggest each and every limitation of the claimed invention. MPEP § 706.02(j). The teaching or suggestion to make the claimed invention *and* the reasonable expectation of success must *both* be found in the prior art, not in the Applicants' disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). If any one of these criteria is not met, *prima facie* obviousness is not established.

It is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness against presently pending Claims 11-14 because, at a minimum, the references cited by the Examiner, alone or in combination, fail to teach or suggest each and every limitation of these claims.

Applicants submit that the present claims do not relate to controlled release hydromorphone compositions as disclosed by Goldie, but instead relate to controlled release oxycodone hydrochloride formulations which provide at least a 12 hour therapeutic effect to a human patient in pain. The active agent disclosed in Goldie is hydromorphone or a salt of hydromorphone. Goldie does not disclose the use of oxycodone hydrochloride.

Applicants submit that, due to the chemical and biological differences between hydromorphone or a salt of hydromorphone and oxycodone hydrochloride, one of ordinary skill in the art would not have been able to predict whether substitution of oxycodone hydrochloride for hydromorphone or a salt of hydromorphone in the composition disclosed by Goldie would have

resulted in a formulation which is effective for providing at least a 12 hour therapeutic effect to a human patient in pain.

In addition, neither the combination of Goldie and Zierenberg nor Goldie and Hill teach or suggest what applicants are claiming, namely controlled release oxycodone hydrochloride formulations which provide at least a 12 hour therapeutic effect to a human patient in pain. Applicants acknowledge the Examiner's statements that Zierenberg teaches a delayed release tablet comprising an acrylic polymer and a second polymer such as polyvinylpyrrolidone to vary the rate of release of active. However, applicants submit that this does not correct the deficiencies noted above, that Goldie does not disclose an oxycodone hydrochloride formulation which provides at least a 12 hour therapeutic effect to a human patient in pain. Zierenberg neither teaches nor suggests that oxycodone hydrochloride may be used in its delayed release tablet. In fact, the sole medicaments disclosed in the example section of Zierenberg are clonidine base and etilefrin base. Similarly, applicants acknowledge the Examiner's statements that Hill teaches a controlled release tablet for use with a wide variety of medicaments, comprising a carboxy vinyl polymer and polymeric vinyl pyrrolidone. As before, this combination does not disclose an oxycodone hydrochloride formulation which provides at least a 12 hour therapeutic effect to a human patient in pain. While Hill discloses numerous medicaments for use in its controlled release tablet, the use of oxycodone hydrochloride is not disclosed.

The Examiner further stated: "[a]s to the claimed release rate, such must be achieved by the obvious composition because it is the same as that claimed." Applicants respectfully disagree. For the reasons stated above, neither Goldie nor Zierenberg, either alone or in combination, teach or suggest what applicants are claiming, controlled release oxycodone hydrochloride formulations which provide at least a 12 hour therapeutic effect to a human patient in pain. Thus, the compositions claimed in the present invention are not the same as those disclosed in Goldie or Zierenberg. Therefore, in contrast to the Examiner's statements, no inference can be drawn regarding the release rate of the oxycodone hydrochloride formulations of the present invention by comparison to either Goldie or Zierenberg.

Further, applicants respectfully submit that there existed no motivation to combine the references cited by the Examiner, and that the combination of references by the Examiner is, therefore, improper hindsight. The Federal Circuit has stated "[t]he motivation to combine references can not come from the invention itself." *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d 1068 (Fed. Cir. 1993). One of ordinary skill in the art would not be motivated to take the hydromorphone formulations of Goldie and use them in combination with the controlled release formulations disclosed in either Zierenberg or Hill in order to prepare oxycodone hydrochloride formulations having at least a 12 hour therapeutic effect.

In sum, the art cited does not teach or suggest a method of preparing oxycodone hydrochloride formulations which provide at least a 12 hour therapeutic effect to a human patient, as

is disclosed and taught in the present case.

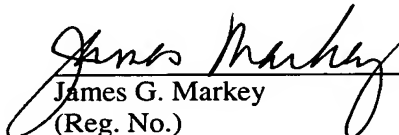
For the reasons discussed above, none of the references cited by the Examiner, alone or in combination, render the methods recited in claims 11-14 obvious. Accordingly, applicants respectfully request that the rejections under 35 USC § 103(a) be withdrawn.

### CONCLUSION

Entry of the foregoing remarks and amendments is respectfully requested. No fees beyond those for the extension of time are believed to be due with this Amendment. However, if any fee is required, please charge the fee to Jones Day Deposit Account No. 503013.

Respectfully submitted,

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